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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/575,186	05/23/2000	Kia Silverbrook	NPA020US	9156

24011 7590 08/23/2006

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, NSW 2041  
AUSTRALIA

EXAMINER
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JUNG, DAVID YIUK

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/575,186

Applicant(s)

SILVERBROOK ET AL.

Examiner

David Y. Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-28 and 32-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-28 and 32-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **CLAIMS PRESENTED**

Claims 1-3, 5-28, 32-45 are presented.

### **CLAIM REJECTIONS**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-28, 32-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ikeda (cited by Applicant, Abstract of Japan Patent Application number 08305112), Johnson (cited by Applicant, European Patent Application number 91304880.7, Publication number 0459793A1), and Sekendur (cited by Applicant, WIPO PCT International Application Number PCT/US/95/16913, International Publication Number WO 97/22959).

Regarding claim 1, Ikeda teaches a "photo album." See solution section (i.e. album editor 1 using photograph data).

Ikeda is not explicit about other features.

Johnson teaches "A method of enabling the creation and use of a ... via at least one ... form printed on a surface, the ... form containing graphic information relating to a

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... activity and a plurality of tags, each tag containing dot code identifying the ... form and a location of that tag on the ... form (column 4, line 18 to column 6, line 39; i.e. forms which “facilitate proper location of markings” – e.g., column 6, line 34).”

Ikeda and Johnson are not explicit about other features.

Sekendur teaches “the method comprising the steps of:

receiving, in a computer system, indicating data from a sensing device operated by said user, said indicating data regarding the identity of the ... form and a position of the sensing device relative to the ... form, the sensing device, when placed in an operative position relative to the ... form, generating the indicating data by sensing at least some of the dot code; and identifying in the computer system and from the indicating data, at least one parameter relating to the ... activity (page 4 to page 6, first paragraphs, i. e., position related coding means, writing surface, etc.).”

Ikeda (at Solution section) and Johnson (at column 6, line 34) and Sekendur (at first two paragraphs of page 3) all teach to combine the teachings with such other image handling devices for the motivation of providing ease for the user.

It would have been obvious at the time of the claimed invention to combine teachings of Ikeda, Johnson, Sekendur so as to teach the claimed invention for the motivation noted in the previous paragraphs.

Regarding claim 26, Ikeda teaches a “photo album.” See solution section (i.e. album editor 1 using photograph data).

Ikeda is not explicit about other features.

Johnson teaches "A system for enabling the creation and use of a ... via at least one ... form printed on a surface, the ... form containing graphic information relating to a ... activity and including a plurality of tags, each tag containing a dot code identifying the ... form and a location of that tag on the ... form (column 4, line 18 to column 6, line 39, i.e. forms which "facilitate proper location of markings" – e.g., column 6, line 34)."

Ikeda and Johnson are not explicit about other features.

Sekendur teaches "said system comprising:

"a computer system for receiving indicating data from a sensing device operated by a user involved in the ... activity; said indicating data regarding the identity of the ... form and a position of the sensing device relative to the ... form, the sensing device, when placed in an operative position relative to the ... form, sensing the indicating data using at least some of the dot code, said computer system including means for identifying, from the indicating data, at least one parameter relating to the ... album activity (page 4 to page 6, first paragraphs, i. e., position related cording means, writing surface, etc.)."

Ikeda (at Solution section) and Johnson (at column 6, line 34) and Sekendur (at first two paragraphs of page 3) all teach to combine the teachings with such other image handling devices for the motivation of providing ease for the user.

It would have been obvious at the time of the claimed invention to combine teachings of Ikeda, Johnson, Sekendur so as to teach the claimed invention for the motivation noted in the previous paragraphs.

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Regarding claims 2-3, 5-25, 27-28, 32-45, the limitations specific to these claims have been discussed in the previous Office Actions. For the reasons stated therein, these claims are not patentable.

***Conclusion***

The art made of record and not relied upon is considered pertinent to applicant's disclosure. The art disclosed general background.

***Points of Contact***

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(571) 273-8300, (for formal communications intended for entry)

**Or:**

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(571) 273-3836 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Jung whose telephone number is (571) 272-3836 or Jacques Louis-Jacques whose telephone number is (571) 272-6962.

David Jung

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A handwritten signature in black ink, consisting of a series of loops and a long horizontal stroke extending to the right.

Patent Examiner

8/21/06